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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,147	01/31/2002	Lorin R. Sutton	06975-211001 / Network 09	5982
26171	7590	04/26/2006	EXAMINER POLTORAK, PIOTR	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 2134	PAPER NUMBER

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/059,147		SUTTON ET AL.	
	Examiner		Art Unit	
	Peter Poltorak		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 30-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 30-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 44-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 and 30-43 drawn to a method of identifying unwanted messages, classified in class 726, subclass 22.
- II. Claims 44-51 drawn to a method of classification of a message, classified in class 726, subclass 1.

Inventions (I) a method of identifying unwanted messages and (II) a method of classification of a message related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (II) drawn to a method of classification of a message, classified in class 726, subclass 1 do not require inspecting of the payload portion of a message for example, and invention (II) drawn to a method of identifying unwanted messages, classified in class 726, subclass 22 do not require a message communicated with a set of rules for example.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-51 are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

1. The Amendment, and remarks therein, received on 2/7/06 have been entered and carefully considered.
2. The Amendment introduces a new limitation into the originally sole independent claims 1 and dependent claims 6-7, 9-12, cancels claim 5 and adds new claims 30-51.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. The new Oath/Declaration received on 2/7/06 is accepted.
5. In light of the amendments introduced to claims 7 and 10 the previous 35 U.S.C. 112, second paragraph Office Action rejection directed towards 7, 1, 23 and 26 are withdrawn.

6. In regard to the art rejection applicant's arguments are essentially directed towards the "recategorizing the security condition of the message based on the updated stored data". Applicant argues that the art of record does not disclose and does not suggests such a limitation.
7. Applicant's arguments have been carefully considered but they were not found persuasive.
8. Cotten discloses categorizing a message with indeterminate condition (flag the message for later processing, col. 4 lines 36) and clearly states that the mail can be
9. Claims 1-15 and 30-43 have been examined.

Claim Objections

10. Claims 36-37 are objected to because of the following informalities: "at one least one" should be "at least one". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 36 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. In particular no recategorizing the security condition of the message when an alarm score decreases was found in the applicant's specification.

12. Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the phrase "when the stored data is updated such that ..." is not clear. It is not clear whether the claims limitation should be read as though increasing an alarm score of at least one of the characteristic of a message results in recategorizing the security condition of the message or whether the limitation implies that recategorizing the security condition of the message results in an alarm score of at least one of the characteristics of a message increase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-15, 30-35 and 38-43.

14. As per claims 1-15 and 30-43 Paul teaches inspecting a message being communicated to a first device in a message exchanging system that includes two or more devices and identifying characteristics of the message (col. 5 lines 1-10),

comparing the characteristics of the message with data in the message exchanging system (col. 5 lines 56-62 and Fig. 2 and col. 5 line 63-col. 6 line 15), based on comparison results, identifying a security condition from among at least one of acceptable, unacceptable (col. 6 line 5-col.7 line 10), processing the message based on the security condition (col. 6 line 5-col.7 line 10), wherein the processing the message includes rejecting the message if the security condition associated with the message reflects that unacceptable state (col. 6 lines 5-50 and col. 6 line 64-col.7 line 1), accepting the message if the security condition associated with the message reflects the acceptable state (col. 6 lines 52-55 and col. 7 lines 8-10).

15. Paul teaches that the characteristics of the payload portion include information other than address information (col. 9 lines 51-52).

Paul does not teach that if the security condition associated with the message reflects the indeterminate state, inspecting at least one other message subsequent to the processing of the message and assuming a message when comparison of the characteristics reveals a threshold number of messages having a shared characteristic.

Cotten discloses indeterminate state messages condition, inspecting subsequent messages to detect undesired conditions (Cotten, col. 4 lines 35-36 and 46-58) and assuming a message when comparison of the characteristics reveals a threshold number of messages having a shared characteristic (col. 4 lines 21-24).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to inspect at least one other message subsequent to the processing of the

message if the security condition associated with the message reflects the indeterminate state and assuming a message when comparison of the characteristics reveals a threshold number of messages having a shared characteristic (col. 4 lines 21-24) as taught by Cotten, given the benefit of more accurate security assessment and proper treatment of unwanted bulk messages . Paul in view of Cotten does not explicitly teach updating the stored data to indicate characteristics of the at least one other message that has been inspected. However, the limitation is implicit. As clearly disclosed by Paul, filtering exclusion lists is automatically created, maintained and modified based upon filtering instructions received from a control center (Paul, col. 6 lines 10-15) and the control center receives the information based on the constantly incoming messages (Paul, col. 4 lines 19-67). Similarly implicit would have been reprocessing (rescanning) and recategorizing the security condition of the message (or any of the indetermined messages) based on the updated stored data especially since viruses and spam continuously mutate and something that is not clearly identified at the very moment can clearly be identified as time progress, as also clearly shown in Cotten's invention (e.g. Cotten, col. 4 lines 35-36).

16. Rejecting/deleting the message if the security condition identified includes a hostile indicator would have been implicit.

17. As per claim 41 Paul in view of Cotten does not explicitly teach reprocessing the message includes generating an alarm if the security condition reflects the unacceptable state. However, the computer systems frequently (also as shown by

Paul, above) work automatically without a user interaction. As a result, an alarm (identifying a particular condition) must be present for the system to recognize the need for executing a particular routine (e.g. reprocess a message).

18. As per claims 38-39 Paul in view of Cotten do not teach recategorizing the security condition based on an administrator updates. However, Official Notice is taken that it is old and well-known practice to recategorize the security condition based on an administrator's update (e.g. removing or adding a sender's address from a SPAM list per request of a user for example). It would have been obvious to recategorize the security condition based on an administrator's update given the benefit of immediate response to incorrect classification.

Conclusion

Claim 36 as best understood overcomes the art of record.

Neither Paul nor Cotton teach utilizing an alarm score in recategorizing a traced message categorized with indeterminate state condition. Even if one argued that it would have been obvious to utilize an alarm score in recategorizing the message if the alarm score increased it would have not been obvious to one of ordinary skill in the art at the time of applicant's invention to recategorize the message if the alarm score decreased. Although it is old and well-known practice to keep messages with indeterminate state condition (e.g. quarantine) and use a warning level when particular characteristics occur (e.g. warn an administrator when a number of received messages with a particular characteristics are received) the found prior analogous art did not

suggest recategorizing the state condition of a message when the alarm score is decreased.

In case of any amendments, especially any amendments to the limitations of claims 36-37, applicant is advised to clearly articulate the claim invention as well as provide support in the specifications.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 6,460,050,

U.S Patent No. 6,643,686.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PdM
4/20/06

Jacques Louis Jacques
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PRIMARY EXAMINER